



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,759	12/30/2004	Kenneth S. Hoffman	HKS-102-A-PCT-US	3197
7590 10/16/2008				
Weintraub Group				
32000 Northwestern Highway				
Suite 240				
Farmington Hills, MI 48334				
EXAMINER				
DARNER, CHRISTOPHER J				
ART UNIT		PAPER NUMBER		
3633				
MAIL DATE		DELIVERY MODE		
10/16/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/519,759

**Applicant(s)**

HOFFMAN, KENNETH S.

**Examiner**

CHRISTOPHER J. DARNER

**Art Unit**

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-9 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-9 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

***Specification***

1. The amendment filed October 15, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Paragraph [0027], it is preferred that the legs overlap such that each leg has three distinct portions: ...and a third middle portion both overlies an adjacent leg and underlies an adjacent leg. The medial portion has not been defined on the leg and was not in the original disclosure. Therefore, since the reference drawings are not to scale, the subject matter is not believed to be shown and the drawings cannot be relied upon for providing support for the added subject matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**3. Claims 1-2, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Zdeb et al. (US. PGPUB 2003/0046878).**

**With respect to claim 1,** Zdeb discloses a roof flashing strip comprising an elongated member (32) having a backing plate (34) and succession of substantially parallel legs (36) projecting laterally outwardly therefrom and substantially normal thereto in Figure 1b, 2a, and 2b. Zdeb discloses the legs being inclined with respect to a horizontal plane at an angle of at least one degree and each leg having opposed first and second edge portions and a medial portion extending between the edge portions wherein at least some of the succession of legs form a set of three succeeding legs, the medial portion of the second leg overlying the second edge portion of the first leg and underlying the first edge portion of the third leg, and wherein the second edge portion of the first leg underlies the first edge portion of the third leg at page 2, [0035], line 5-11.

**With respect to claim 2,** Zdeb discloses the roof flashing strip wherein the angle ranges from about one degree to about five degrees at page 5, [0035], line 9-11.

**With respect to claim 5,** Zdeb discloses the roof flashing strip wherein a gap is defined between the overlying portion of the legs in Figure 1b, 2a, and 2b.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zdeb et al. (US. PGPUB 2003/0046878) in view of Bodycomb (U.S. Patent # 5,414,964).**

**With respect to claim 6,** Zdeb does not teach a method of manufacturing a roof flashing strip which comprises extruding the roof flashing strip. Bodycomb teaches a method of manufacturing a roof flashing strip which comprises extruding the roof flashing strip at column 4, lines 33-36. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a method of manufacturing a roof flashing strip which comprises extruding the roof flashing strip taught by Bodycomb in order to allow for easy manufacturing of various shapes and dimensions.

**With respect to claim 7,** Zdeb teaches the method wherein the roof flashing strip is formed from a plastic material or a metal material at page 3, [0046], lines 1-4.

**With respect to claim 8,** Zdeb teaches the claimed invention except for wherein the roof flashing strip is formed from a plastic material selected from a group consisting

of polyvinylchloride, high density polyethylene, polyurethane, and polyvinylacetate. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to roof flashing strip from a group consisting of polyvinylchloride, high density polyethylene, polyurethane, and polyvinylacetate, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material. It would have been obvious to use plastic for the device, because plastic will not rust and deteriorate when exposed to the weather.

**With respect to claim 9**, Zdeb teaches the method wherein the roof flashing strip is formed from aluminum at page 1, [0003], lines 1-3.

**6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zdeb et al. (WO/2002/063113) as applied to claim 1 above, and further in view of Lewellin (U.S. Patent # 4,941,304).**

**With respect to claim 12**, Zdeb teaches a roof slashing system comprising a roof flashing strip in Figure 1b, 2a, and 2b.

Zdeb does not teach a base strip, the base strip comprising an elongated member having a backing plate, the backing plate having a top strip and a bottom strip which project outwardly therefrom and extend laterally along the backing plate, and the top strip and bottom strip being inclined with respect to a vertical plane at an angle of at

least one degree. Lewellin teaches a base strip, the base strip comprising an elongated member having a backing plate (22), the backing plate having a top strip (20) and a bottom strip (21) which project outwardly therefrom and extend laterally along the backing plate, and the top strip and bottom strip being inclined with respect to a vertical plane at an angle of at least one degree at column 2, lines 52-55. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a base strip, the base strip comprising an elongated member having a backing plate, the backing plate having a top strip and a bottom strip which project outwardly therefrom and extend laterally along the backing plate, and the top strip and bottom strip being inclined with respect to a vertical plane at an angle of at least one degree as taught by Lewellin in order to an opening in which to fit a shingle.

### ***Response to Arguments***

7. Applicant's arguments filed August 7, 2008, have been fully considered but they are not persuasive.

In response to applicant's argument regarding claim 1 that Zdeb does not show wherein at least some of the succession of legs have a first portion overlying the medial portion of the next adjacent preceding leg and the opposite second edge portion underlying the medial portion of the next adjacent succeeding leg as per Figure 1b, 2a, and 2b, the examiner respectfully disagrees. Figure 2a clearly illustrates a first portion

overlying the medial portion of the next adjacent preceding leg and the opposite second edge portion underlying the medial portion of the next adjacent succeeding leg as describe in claim 1.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument regarding claim 12 that Lewellin does not have a top strip and a bottom strip which are inclined with respect to a vertical plane, the examiner respectfully disagrees. The top strip (20) and bottom strip (21) deviate from the vertical plane by at least one degree which means they are inclined from the vertical plane. Both strips are attached to the backing plate (22) which extends in the vertical plane, but that does not mean both strips cannot be inclined with respect to the backing plate. Both strips are in parallel horizontal planes that are inclined with respect to backing plate which in a vertical plane by about 90 degrees. Ninety degrees is greater than at least one degree.

In response to applicant's argument that Lewellin is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this



case, Lewellin has the basic structure of a base strip with a backing plate having a top strip and bottom strip. The structure of an insulation body can be found in a roofing element such as a flashing strip.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **CHRISTOPHER J. DARNER** whose telephone number

is (571)270-3658. The examiner can normally be reached on Monday thru Friday 7:30AM to 4:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian V. Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Darnier/  
Examiner, Art Unit 3633

/Brian E. Glessner/  
Supervisory Patent Examiner, Art Unit 3633